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08/419,824	04/11/95	COCHRANE	TSRI-147.200

EXAMINER

18N2/0612

ART UNIT	PAPER NUMBER
1811	11

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DATE MAILED: 06/12/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 3/10/97 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-46 are pending in the application.

   Of the above, claims 10, 11, 18-20, 23, 24, 45 + 46 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-9, 12-17, 21, 22, 25-44 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Restriction/Election

The restriction requirement is withdrawn. The election of species is maintained and it will be applied to the claims now rejoined.

Claims 1-46 are pending.

Claims 1-9,12-17,21,22,25-33 as well as 34-44 read upon the elected species.

Claims 10,11,18-20,23,24,45 & 46 are withdrawn as drawn to non-elected species.

Double Patenting

Statutory Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

No claims are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims of prior U.S. Patent No. 5164369 to Cochrane as none are drawn to the elected species. (This reference may be applied should the consideration of the claims to their embodiments beyond the elected species be considered). This is a statutory double patenting rejection.

Claims 1-9,12,17,21,22,25,29-33 as well as 34-36,39,43 & 44 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims of prior U.S. Patent No. 5260273 to Cochrane as drawn to the elected species. (This reference may be applied further should the consideration of the claims to their embodiments beyond the elected species be considered). This is a statutory double patenting rejection.

Claims 1-9,12,17,21,22,25,29-33 as well as 34-36,39,43 & 44 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims of prior U.S. Patent No. 5407914 to Cochrane as drawn to the elected species.

(This reference may be applied further should the consideration of the claims to their embodiments beyond the elected species be considered). This is a statutory double patenting rejection.

No terminal disclaimer will overcome these rejections as they are statutory double patenting.

Non-Statutory Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 1-9,12,17,21,22,25,29-33 as well as 34-36,39,43 & 44 are rejected under the judicially created doctrine of double patenting over the claims of U. S. Patent Nos. (5260273 or 5407914, both to Cochrane) since the claims, if allowed, would improperly extend the "right to exclude" already granted in these patents.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 13-16,26-28,37,38 & 40-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of U.S. Patent Nos. (5260273 or 5407914, both to Cochrane) in view of Jackson 4861756.

The claims rejected are dependently drawn to combinations of species and amounts of specific phospholipids all conventionally utilized in the pulmonary surfactant art, see Jackson at column 3 generally as well as the examples.

It is the examiners position that it would have been **prima facie** obvious to one of ordinary skill in the art at the time of the invention to have utilized the specifically claimed combinations of the phospholipids as disclosed in Jackson as they are conventially used and art recognized as equivalent alternatives in the absence of any unexpected results.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick R. Delaney whose telephone number is (703) 308-4324.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

Patrick R.Delaney
June 7, 1997

CECILIA J. TSANG
SUPERVISORY PATENT EXAMINER
GROUP 1800